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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/054,565	04/03/98	SIMPSON	P-3489.027

LARRY L COATS
RHODES COATS & BENNETT
PO BOX 5
RALEIGH NC 27602

QM22/0314

EXAMINER
GOODMAN, C

ART UNIT	PAPER NUMBER
3724	14

DATE MAILED: 03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/054,565

Applicant(s)

SIMPSON, JACK RICHARD

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 22, 23 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. The Amendment filed on September 1, 2000 has been entered.
2. In view of the Appeal Brief filed on January 5, 2001, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "weighted" scrap stripper (claim 24) must be shown or the feature canceled from the claim. No new matter should be entered.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "S" (p. 12, l. 5). Correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8-14, 16-17, 19, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i. In claim 8, clause (e), the term “it” is vague and indefinite. What is “it” referring to? The same applies to the rest of the claims. In line 9, the phrase “the direction of movement..” lacks clear antecedent basis.
- ii. The following phrases lack clear antecedent basis: (claim 9) “the height”; (claim 16) “the direction of travel of the cutting die” (no “travel direction” has been set forth for the cutting die); and (claim 26) “the influence of centrifugal force”.
- iii. Claim 11 is vague and indefinite in that it is not clear what the claim encompasses. It appears to be a double inclusion of the same previously recited. If not, then what is the difference? The same applies to claims 12-13.
- iv. Claim 16 is vague and indefinite in that it is not clear what the claim encompasses. What is encompassed by “adapted to work in conjunction with a rotary anvil”? How is the rotary die “adapted to work”? Due to the nature of the art, the scope of the limitation is unascertainable. Substantially the same applies to claim 26.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-4, 6, 15-17, 19, 20, 21, 24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Rilitz et al.

Rilitz et al discloses a cross cutter comprising all the elements claimed including, *inter alia*, a base (7, 9); at least one scrap cutting blade (8, 11); and at least one scrap stripper (13, 14). See whole patent.

9. Claims 1-6, 8-17, 19, 20, 21, 24, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Okonski.

Okonski discloses a cutting die system comprising all the elements claimed including, *inter alia*, a base (30); at least one scrap cutting blade (50); and at least one scrap stripper (40). See Figs. 1-4.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 7, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Rilitz et al.

Regarding claim 5, Rilitz et al discloses the invention substantially as claimed except for a plurality of scrap strippers. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Rilitz et al with a plurality of scrap strippers in order to facilitate stripping of larger area of the work piece, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 7 and 18, Rilitz et al discloses the invention substantially as claimed including the stripper being made from rubber material. See c. 4, ll. 28-33. However, Rilitz et al does not set forth a specific range of durometer. In that regard, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Rilitz et al with the claimed durometer range in order to obtain the desired elastomeric characteristic, since rubber material inherently includes a certain range of durometer values, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

12. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Okonski.

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Okonski discloses the invention substantially as claimed except for the stripper being made from rubber material and durometer range. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Okonski with the claimed rubber material and durometer range in order to use a material with the desired stripping characteristic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, *In re Leshin*, 125 USPQ 416, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

13. Claims 1-21, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithwick Jr. et al in view of Okonski.

Smithwick Jr. et al discloses the invention substantially as claimed except for the flexible fingers 24 (on one row of fingers) extending outwardly over the base at an acute angle. However, Smithwick Jr. et al already teaches that the angular orientation of the fingers along with the adjacent notches allows the stripper to absorb compressive forces during the cutting operation while at the same time rebound to longitudinally direct a force which helps to free the scrap. See c. 4, ll. 11-28. Along that line, Okonski teaches a stripper (40) including a base (30) and flexible fingers extending outwardly over the base and at an acute angle within the range as claimed which suggests lessening of the compressive forces that the stripper experiences during the cut strip deflection and guidance operation while maintaining sufficient rebound longitudinal strength (force) to deflect and guide the cut portion of the web (70). See Figs. 1-4. Thus, it would have

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been obvious to the ordinary artisan at the time of the instant invention to provide the device and method of Smithwick Jr. et al with the finger extending over the base of the stripper at an acute angle as taught by Okonski in order to enhance the absorption of the compressive forces without compromising the longitudinally directed force required to free the scrap.

Response to Arguments

14. Applicant's arguments with respect to claims 1-21, 24, and 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].


All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet

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communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.


Charles Goodman
Patent Examiner
AU 3724

cg 
March 12, 2001